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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/339,605	06/24/1999	DAVID L. PATTON	79296F-P	2805

1333 7590 02/28/2003

PATENT LEGAL STAFF  
EASTMAN KODAK COMPANY  
343 STATE STREET  
ROCHESTER, NY 14650-2201

EXAMINER
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WALLERSON, MARK E

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 02/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/339,605

Applicant(s)  
Patton et al

Examiner  
Mark Wallerson

Art Unit  
2622



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Jan 21, 2003
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-3, 6, 7, 9-11, 18-20, and 28 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6, 7, 9-11, 18-20, and 28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 6 6) ☐ Other:

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### **Part III DETAILED ACTION**

#### ***Notice to Applicant(s)***

1. This action is responsive to the following communications: amendment filed on **11/6/2002**.
2. This application has been reconsidered. Claims 1-3, 6, 7, 9-11, 18-20, and 28 are pending.

#### ***Allowable Subject Matter***

3. The indicated allowability of claims 18, 19, 20, and 28 is withdrawn in view of the newly discovered reference(s) to Abe et al (Abe). Rejections based on the newly cited reference(s) follow.

#### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

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The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1, 2, 3, 6, 7, 11, 18, 19, and 28 are rejected under 35 U.S.C. 102(e) as being anticipated by Abe et al (Abe) (U. S. 6,499,822).

With respect to claims 1 and 7, Abe discloses obtaining a digital image file containing an image for printing by a digital printer (column 14, lines 50-65); printing the image onto a media (column 14, lines 50-65); printing a coordinate system (boundary lines) on the medium over the image that is not visible to the human eye under normal viewing conditions separate from the printing of the image, the coordinate system being capable of locating a specific area of the image on the print (column 16, lines 7-52; column <sup>15</sup>~~14~~, lines 1-8, and column 19, lines 7-24); and printing additional information (1503) on the media that provides information with respect to the content of the image at the specific area (column 15, lines 35-41).

With respect to claim 2, Abe discloses scanning the additional information (column 15, lines 42-47).

With respect to claim 3, Abe discloses the information is printed directly over the image (column 15, lines 35-41).

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With regard to claim 6, Abe discloses the additional information is obtained by a single scanning operation (column 15, lines 42-54).

With respect to claim 11, Abe discloses an ink-jet printer (column 15, lines 35-41).

With regard to claim 18, Abe discloses a method for printing an image on a medium having a pre-printed coordinate system, (the abstract, lines 1-6 and column 13, lines 4-17), the pre-printed coordinate system is not visible to the human eye under normal viewing conditions (column 11, lines 37-47), comprising scanning the media so as to determine if the preprinted coordinate system is provided (column 11, lines 50-65); providing an image to be printed on the media which has information specific to a particular location on the image which can be defined by the coordinate system (column 15, lines 1-27), and printing an image on the media in accordance with the coordinate system (column 15, lines 1-27).

With regard to claim 19, Abe discloses modifying the image prior to printing (column 19, lines 7-24).

With regard to claim 28, Abe discloses enlarging the image (which reads on correcting the shape of the image) (figure 14).

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

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such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abe in view of Nelson (U. S. 6,132,024).

With respect to claims 9 and 10, Abe differs from claims 9 and 10 in that he does not clearly disclose that the print is made on paper. Nelson discloses a printing system using paper as the print medium (column 1, lines 40-45). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Abe wherein the print is made on paper. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Abe by the teaching of Nelson in order to vary the print output mediums.

8. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Abe in view of Lopresti et al (Lopresti) (U. S. 5,862,270).

With respect to claim 20, Abe differs from claim 20 in that he does not clearly disclose cropping the image. Lopresti discloses a system having encoded image data wherein the image is located and cropped (column 8, lines 39-48). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Abe wherein the image is cropped. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Abe by the teaching of Lopresti in order to improve the image processing.

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## SECTION 2

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1, 2, 3, 6, 7, 9, 10, 11, are rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson (U. S. 6,132,024) in view of Hakamatsuka (U. S. 5,410,642).

With respect to claims 1, 2, and 7, Nelson discloses a method for making a digital print comprising the steps of obtaining a digital image file for printing by a printer (receiving text or images) (column 2, lines 3-6); printing the image onto media using a digital printer (column 3, lines 20-25), and printing a coordinate system (positional-calibration indicia) on the media over the image (which reads on overprinting the invisible ink over the visible ink) (column 4, lines 21-24) that is not visible to the human eye separate from the printing of the image (column 4, lines 21-31), the coordinate system being capable of locating a specific area on the print (column 2, lines 22-28).

Nelson differs from claims 1 and 7 in that he does not clearly disclose printing additional information with respect to the content of the image at specific areas.

Hakamatsuka discloses printing attribute information (16) which is not visible to the human eye under normal viewing conditions (in infrared ink) with respect to the content of the

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image at specific areas (column 6, lines 37-56), along with other information (column 7, lines 14-29). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Nelson to print additional information with respect to the content of the image at specific areas. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Nelson by the teaching of Hakamatsuka in order to increase the amount of information that the user may place on the document.

With respect to claims 3 and 6, Nelson discloses that the coordinate system is printed over the image (column 4, lines 21-24).

With regard to claim 11, Nelson discloses an inkjet printer (column 6, lines 7-11).

With respect to claims 9 and 10, Nelson discloses that the print is made on paper (column 1, lines 40-45).

### ***Response to Arguments***

11. Applicant's arguments with respect to claims 1 and 7 have been considered but are moot in view of the new ground(s) of rejection.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Wallerson whose telephone number is (703) 305-8581.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Any response to this action should be mailed to:



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Commissioner of Patents and Trademarks

Washington, DC 20231

or faxed to:

(703) 872-9314 (for formal communications intended for entry)

(for informal or draft communications, such as proposed amendments to be discussed at an  
interview; please label such communications "PROPOSED" or "DRAFT")

or hand-carried to:

Crystal Park Two

2121 Crystal Drive

Arlington, VA.

Sixth Floor (Receptionist)

**MARK WALLERSON**  
**PRIMARY EXAMINER**



MARK WALLERSON